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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,443	12/09/2004	Yusuke Shimizu	05905-0179	8650
22852	7590	03/23/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER WONG, JEFFREY KEITH	
			ART UNIT	PAPER NUMBER
			3714	
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			03/23/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/517,443

Applicant(s)

SHIMIZU ET AL.

Examiner

Jeffrey K. Wong

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18, 20 and 23-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18, 20, 23-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Application

1. This Office-Action acknowledges the Request for Reconsideration filed on 1/16/2009 and is a response to said request.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 18, 20, 23-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benoy, US Patent 6,896,618(Benoy) in view of Kirmse et al., US 2008/0171601(Kirmse). Regarding Claim 18, 24, 26.

Benoy teaches a game system including an arcade game machine installed in a play facility with which a player plays a game after paying a play fee(Col 1, lines 20-34.

Casino games require a player to pay a fee to play), and a server device connected to the arcade game machine via a network(Abstract. The loyalty program server is connected to the gaming machine), the game system being configured to perform:

(a) registering identification information unique to the player on the server device (Abstract. Players must enter identification information before playing a game);

(c) allowing the player to play the game on the arcade game machine when the identification information transmitted from the player meets the identification information

stored on the server(Col 8, 1-3. Players will be able to play the game and accumulate loyalty points after validating their identification); and

Benoy failed to disclose:

(b) after the registering, allowing the player to store on the server device an optional message in advance in association with the registered identification information and in association with an event of the game to be played, which is designated by the player who expects the event to occur during a progress of the game to be played before allowing the player to start the game on the arcade game machine, said optional message being arranged to be sent from the server device to a terminal device optionally designated in advance by the player

(d) transmitting the optional message from the server device to the terminal device optionally designated in advance by the player so that the optional message is displayed on the terminal device when the event has occurred on the arcade game machine during the progress of the game after starting the game.

However, Kirmse teaches of a game and messenger client-server system is provided that includes a plurality of game clients, a game server, a plurality of messenger clients, and a messenger server(Abstract) where it is well known with the advent of the global inter-network of networks generally referred to as "the Internet," communication between users connected to the Internet has been facilitated by programs such as email and instant messaging (para 3). Kirmse also teaches that if a buddy logs on with their messenger client, each buddy is notified of the new state (e.g., "logged on").If one of those notified buddies is in a game, that buddy's messenger will

send back a message to the newly logged on user with the game information so the newly logged on buddy will have the information to display a game icon, invoke a game, etc.(para 68). Kirmse also teaches of an optional messaging system such that when an invitee messenger client receives a message that a buddy is playing a game, the invitee messenger client decodes the message as needed to invoke the game and optionally send a message to the census process(para 71). This messaging system is used for coupling a game client to a messenger client to allow the game client to send the messenger client data used to initiate joining a game, whereby a message sent by the messenger client includes the data used to initiate joining a game. Also, logic is included for initiating a join of a game at an invitee client, using data received in a message to the invitee(Abstract).

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art to implement Kirmse's messaging system teachings with Benoy's loyalty program system as means of allowing players to invite others into joining their games as taught by Kirmse.

Regrading Claim 20.

Kirmse teaches calculating points acquired as a result of the player's game play, wherein the optional message is stored on the server device in association with a certain value of points to be acquired by the player before starting the game.(para 53, 69-70 and 97. In this case, the point system in which is calculated is represented by the

"1" which would represent the flagging of the player which would mean the player is online and playing a game in where another player can join)

Regrading Claim 23.

Kirmse teaches wherein plural ones of the optional messages which are stored in relation with certain values of game points, respectively, one of which is given to the player in accordance with a result of the game executed by the player(para 53, 69-70, and 97).

Regrading Claim 25.

Kirmse teaches wherein said optional message contains plural messages which are stored in relation with certain game stages or statuses as said event designation in advance by the player, respectively(para 97. Players can elect to send messages that allow friends to find them or decline all invitations or send out invitations.)

Regarding Claim 27.

Benoy teaches wherein said designated terminal device is the arcade game machine on which the player plays the game(Abstract. Players play at the designated machine in which said player enters identification information).

Regarding Claim 28.

Benoy teaches wherein said designated terminal device is either another arcade game

machine on which an opponent player plays the game or a mobile terminal device which the opponent player carries(Col 5, lines 26-28).

Regarding Claim 29.

Benoy teaches wherein said designated terminal device is the one of the plurality of game apparatuses on which the player plays the game (Col 4, line 22).

Regarding Claim 30.

Benoy teaches wherein said designated terminal device is either another of the plurality of game apparatuses on which an opponent player plays the game or a mobile terminal device which the opponent player carries(Col 5, lines 26-28).

Regarding Claim 31.

Benoy teaches wherein said designated terminal device is either the other of the plurality of game apparatuses on which the other player plays the game or a mobile terminal device which the other player carries.

Regarding Claims 32, 33.

Benoy teaches a game system comprising a server (abstract) and a plurality of game apparatuses (Col 4, line 22) connected via a network(Col 5, lines 56-57), which is configured to allow one player to play a game on one of the plurality of game apparatuses against another player playing on another of the plurality of game

apparatuses(Col 4, lines 54-64. Bingo is played against another player), said game system being configured to perform:

(a) registering identification information unique to each player (Abstract. Players must input identification information) so that the one player on the one of the plurality of game apparatuses can play the game against the another player on the another of the plurality of game apparatuses.

Benoy failed to disclose

(b) allowing the one player to store on the server an optional message in advance by way of a mobile terminal device operated by the one player, said optional message being a message arbitrarily prepared or designated by the one player, stored on the server in relation to the registered identification information and in relation to an event of the game to be played, which the one player expects to occur during a progress or as a result of the game, and arranged to be displayed on a terminal device designated in advance by the player; and

(c) transmitting the optional message to said designated terminal device from the server so that the message is displayed on the designated terminal device when the event designated in advance by the one player has occurred during a progress or as a result of the game after starting the game.

However, Kirmse teaches of a game and messenger client-server system is provided that includes a plurality of game clients, a game server, a plurality of messenger clients, and a messenger server(Abstract) where it is well known with the advent of the global inter-network of networks generally referred to as "the Internet,"

communication between users connected to the Internet has been facilitated by programs such as email and instant messaging (para 3) and where it is also well known that the implementation of the system on computer systems can be Internet-connectable computers (desktop computers, laptop computers, palm-sized computers, wearable computers, set-top boxes, embedded TCP/IP clients, wireless phones with a user interface, and the like.(para 29). Kirmse also teaches that if a buddy logs on with their messenger client, each buddy is notified of the new state (e.g., "logged on").If one of those notified buddies is in a game, that buddy's messenger will send back a message to the newly logged on user with the game information so the newly logged on buddy will have the information to display a game icon, invoke a game, etc.(para 68). Kirmse also teaches of an optional messaging system such that when an invitee messenger client receives a message that a buddy is playing a game, the invitee messenger client decodes the message as needed to invoke the game and optionally send a message to the census process(para 71). This messaging system is used for coupling a game client to a messenger client to allow the game client to send the messenger client data used to initiate joining a game, whereby a message sent by the messenger client includes the data used to initiate joining a game. Also, logic is included for initiating a join of a game at an invitee client, using data received in a message to the invitee(Abstract).

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art to implement Kirmse's messaging system teachings with Benoy's

loyalty program system as means of allowing players to invite others into joining their games as taught by Kirmse.

Response to Arguments

4. Applicant's arguments with respect to claims 18-20 and 23-33 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey K. Wong whose telephone number is (571)270-3003. The examiner can normally be reached on M-Th 8:30am-7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on (571)272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/
Supervisory Patent Examiner, Art Unit 3714

JKW